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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,949	08/10/2001	Joseph S. Parcels	MM1-105	5403

7590 08/28/2003

Law Offices of William L. Chapin
16791 Sea Witch Lane
Huntington Beach, CA 92649

EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 08/28/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/927,949

Applicant(s)

PARCELS, JOSEPH S.

Examin r

Jessica L. Rossi

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the c rresp ndence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18,20-27 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18,20-27 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____ .
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 6/27/03. Claims 19 and 28-31 were canceled. Claim 36 was added. Claims 1-18, 20-27, and 32-36 are pending. Claims 1-17 withdrawn from further consideration in previous office action, paper no. 2.

2. The rejection of claims 18, 23-28, 30, and 35 under 35 U.S.C. 103(a) as being unpatentable over Magnolfi et al. (of record) in view of Doll (of record) and the Admitted Prior Art in the specification of the present application, as set forth in paragraph 10, of the previous office action has been withdrawn in light of amendments to the claims.

Election/Restrictions

3. Applicant's election of Group II, claims 18-35, in Paper No. 2 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

4. Claims 18, 20-27, and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parcels (US 6018934) in view of Kuhn et al. (US 5711426) and Doll (US 3725170; of record).

***Please note that the primary reference to Parcels has the same inventive entity as the present application while also being available as prior art under 102(b).**

With respect to claims 18, 24, and 36, Parcels teaches an apparatus for attaching a corner protector 40 to a corner of a frame (abstract). The apparatus of Parcels is identical to that of the present invention as clearly depicted in Figures 7-11 of the reference (also note claims 7-23),

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except that *Parcels* teaches a movable staple head 91 for stapling the folded flaps of the corner protector together (Figure 12; column 9, lines 12-14) instead of means for depositing an adhesive onto the flaps.

It is known in the art to join the folded flaps of a corner protector using either staples or adhesive, as taught by the prior art referred to by Kuhn (Figure 8; column 1, lines 34-37 and 41-45). It is also known in the art to apply adhesive to the flaps of a corner protector using means such as movable spray nozzles prior to joining the same, as taught by Doll (column 1, lines 25-26; column 5, lines 37-43).

One reading *Parcels* as a whole would have appreciated that the reference is concerned with the parts of the apparatus used for folding the flaps of a corner protector about a corner of the frame and **not** with the means for attaching these folded flaps to each other; therefore it would have been obvious to use means for depositing adhesive as an alternative to staples for attaching the folded flaps of the corner protector of *Parcels* because such is known in the art, as taught by Kuhn and Doll, and adhesive provides a more aesthetically pleasing product because unlike staples it would not be visible to the user.

Regarding claims 20-22, 25-27, and 32-34, *Parcels* teaches all the limitations (Figures 7-11; claims 7-23).

Regarding claims 23 and 35, Doll teaches the adhesive applying means being an applicator head with at least one nozzle (column 5, lines 40-43).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 18, 20-27, 32-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-27 and 29-40 of U.S. Patent No. 6,418,700 to Parcels in view of Kuhn et al. and Doll et al.


Please note that '700 to Parcels, which is not available under 102(b), 102(a), or 102(e), discloses teachings substantially the same to those of '934 to Parcels; therefore, Applicants are invited to reread the 103(a) rejection set forth above for motivation to use an adhesive applying means as an alternative to a stapling means.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700

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Jessica L. Rossi
Patent Examiner
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A handwritten signature in black ink, appearing to be 'JLR', located to the right of the printed name and title.